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**Fitch, Even, Tabin & Flannery**

*Intellectual Property Law*

## F A C S I M I L E

Name: U.S. Patent & Trademark Office  
FAX: (703) 872-9306  
Application No.: 09/751,609  
Filing Date: December 28, 2000  
Inventor: TRAYLOR, Marc  
Art Unit: 3632  
Examiner: Szumny, Jonathon A.  
From: Eric J. Whitesell, Reg. No. 38,657  
Today's Date: January 12, 2005  
Attorney Docket No.: 3066.001 (73522/7335)  
Pages: 19 pages (including this 1-page coversheet)  
Dispatched by: Susan R. Telford

**Transmitted herewith for filing via facsimile:**

Transmittal Form (1 pg.); Petition to Commissioner (3 pgs.); Copy of Reply Brief filed 6/9/04. Copy includes: fax coversheet, fee transmittal, Reply Brief and fax confirmation from transmitting machine (14 pgs.); Fax coversheet (1 pg.)

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San Diego, California 92131-7701  
Telephone 858-652-4311  
Fax 858-652-0095  
4043597

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**Fitch, Even, Tabin & Flannery**

*Intellectual Property Law*

# F A C S I M I L E

Name: U.S. Patent & Trademark Office

FAX: (703) 872-9306


Application No.: 09/751,609

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Inventor: TRAYLOR, Marc

Art Unit: 3632

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**Fitch, Even, Tabin & Flannery**

*Intellectual Property Law*

## F A C S I M I L E

Name: U.S. Patent & Trademark Office

FAX: (703) 872-9306


Application No.: 09/751,609

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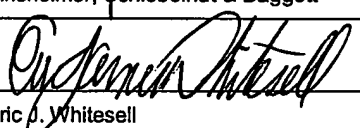
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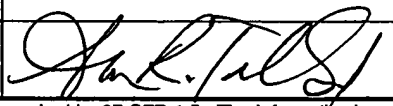
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Telephone 858-552-1311  
Fax 858-552-0095  
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<h1 style="text-align: center;">Transmittal Form</h1> <p style="text-align: center;">(to be used for all correspondence after initial filing)</p>		Application Number	09/751,609	
		Filing Date	12/28/2000	
		First Named Inventor	TRAYLOR, Marc.	
		Art Unit	3632	
		Examiner Name	Szumny, Jonathon A.	
Total Number of Pages in This Submission		19	Attorney Docket Number	3066.001

ENCLOSURES (CHECK ALL THAT APPLY)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts Under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to Technology Center (TC) <input type="checkbox"/> Appeals Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Petition to Commissioner (3 pgs.) Copy of Reply Brief filed 6/9/2004 (14 pgs.) (Copy includes: Fax cover, fee trans., Reply Brief and fax confirmation from transmitting machine) Fax Coversheet (1 pg.)
Remarks:		Customer Number: 26375

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm name	Sinsheimer, Schiebelhut & Baggett		
Signature			
Printed Name	Eric J. Whitesell		
Date	January 12, 2005	Reg No.	38,657

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name	Susan R. Telford		
Signature		Date	January 12, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450 Alexandria, VA 22313-1450. DON NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Petition - page 1 of 3  
09/751,609

DOCKET NO. 3066.001  
FETF: 73522

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): TRAYLOR, Marc  
Serial No.: 09/751,609  
Filed: December 28, 2000  
For: RESILIENT MAGNETIC PAINT  
BRUSH HOLDER  
Art Unit: 3632  
Examiner: Szumny, Jonathon A.

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VA 22313-1450 on the date below.

January 12, 2005

  
Susan R. Telford

**PETITION UNDER 37 C.F.R. § 1.181**

Mail Stop PETITIONS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby submits the following petition to the  
Commissioner in the Appeal pending in the subject application.

STATEMENT OF FACTS

The subject application was filed on December 28, 2000.

On October 6, 2003, Appellant filed an Appeal Brief appealing the final rejection of Claims 1-20.

On December 22, 2003, a Notice of Non-compliance (Paper No. 13) was mailed to Appellant.

On January 14, 2004, Appellant filed an amended Appeal Brief.

On March 9, 2004, an Examiner's Answer (Paper No. 17) was mailed to Appellant.

On June 9, 2004, Appellant filed a Reply Brief with a fee for a one-month extension of time. A copy of the amendment with the certificate of transmission and the fax receipt from the transmitting machine are attached hereto.

On January 10, 2005, Applicant called the examiner to inquire status. The examiner determined that the Reply Brief had not been entered and that the file was to have been forwarded to him on November 5, 2004, but he did not have it.

POINTS TO BE REVIEWED

- (1) that the Reply Brief was timely submitted to the PTO
- (2) whether the file may be located or must be reconstructed

ACTION REQUESTED

1. Appellant petitions that the Reply Brief be entered and

considered by the Board of Appeals.

2. Appellant further petitions that the file be located or reconstructed and forwarded to the appropriate destination.

3. Appellant further petitions that the Board forward a Docketing Notice to Appellant confirming entry of the Reply Brief.

No additional fee is believed due for this petition.

Respectfully submitted,



Eric James Whitesell

Reg. No. 38,657

encl:

- (1) copy of Reply Brief faxed on June 9, 2004
- (2) copy of fee transmittal
- (3) copy of fax cover sheet
- (4) copy of fax confirmation (transmitting machine)

Address all correspondence to:

Sinsheimer, Schiebelhut & Baggett  
1010 Peach Street  
San Luis Obispo, CA 93406

Direct telephone inquiries to:

Thomas F. Lebens  
(805) 781-2865

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**Fitch, Even, Tabin & Flannery**

*Intellectual Property Law*

**F A C S I M I L E**

Name: United States Patent and Trademark Office  
FAX: (703) 305-0942

Today's Date: June 9, 2004  
From: Eric J. Whitesell, Reg. No. 38,657   
Application No.: 09/751,609  
Filing Date: December 28, 2000  
Inventor: Traylor, Marc  
Group Art Unit: 3632  
Examiner: Szumny, Jonathon A.  
Customer No. 26375  
Confirmation No. 8543

Attorney Docket No.: 3066.001 73522/7335  
Pages: Thirteen (13) (including this 1-page coversheet)  
Dispatched by: Rhonda L. Mason

Transmitted herewith via facsimile:

Fee Transmittal (1 pg.); Reply Brief Under 37 C.F.R. § 1.193 (b)(1)  
(11 pgs.); Fax Cover Sheet (1 pg.)






**Fitch, Even, Tabin & Flannery**

*Intellectual Property Law*

**F A C S I M I L E**

Name: United States Patent and Trademark Office  
FAX: (703) 305-0942

Today's Date: June 9, 2004  
From: Eric J. Whitesell, Reg. No. 38,657   
Application No.: 09/751,609  
Filing Date: December 28, 2000  
Inventor: Traylor, Marc  
Group Art Unit: 3632  
Examiner: Szumny, Jonathon A.  
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Attorney Docket No.: 3066.001 73522/7335  
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(11 pgs.); Fax Cover Sheet (1 pg.)

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9276 Scranton Road, Suite 250  
San Diego, CA 92121  
Telephone 858-552-1311  
Fax 858-552-0095

**FEE TRANSMITTAL  
for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT**

(\$55.00)

**Attorney Docket No.**

3066.001 73522/7335

**Complete If Known**

Application Number	09/751,609
Filing Date	December 28, 2000
First Named Inventor	TRAYLOR, Marc
Examiner Name	Szumny, Jonathon A.
Art Unit	3632

**METHOD OF PAYMENT (check all that apply)**
☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account
 Deposit  
Account  
Number  
Deposit  
Account  
Name

501616

Sinsheimer, Schiebelhut &amp; Baggett

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
		1001	770	2001 385 Utility filing fee	
		1002	340	2002 170 Design filing fee	
		1003	530	2003 265 Plant filing fee	
		1004	770	2004 385 Reissue filing fee	
		1005	160	2005 80 Provisional filing fee	

**SUBTOTAL (1)** (\$00.00)**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims	Extra Claims	Fee from below	Fee Paid
	-20**= 0	X 9.00 =	0
Independent Claims	-4**= 0	X 43.00 =	0
Multiple Dependent			

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
		1202	18	2202 9 Claims in excess of 20	
		1201	86	2201 43 Independent claims in excess of 3	
		1203	290	2203 145 Multiple dependent claim, if not paid	
		1204	86	2204 43 **Reissue independent claims over original patent	
		1205	18	2205 9 ** Reissue claims in excess of 20 and over original patent	

**SUBTOTAL (2)** (\$00.00)

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	55.00
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

**SUBTOTAL (3)** (\$55.00)**SUBMITTED BY**

Name (Print/Type) Eric J. Whitesell

Registration No. (Attorney/Agent)

38,657

**Complete (if applicable)**

Telephone 858-552-1311

Signature

Date June 9, 2004

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization of PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 37 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450 Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: TRAYLOR, Marc  
Serial No.: 09/751,609  
Filed: December 28, 2000  
For: RESILIENT MAGNETIC PAINT  
BRUSH HOLDER  
Art Unit: 3632  
Examiner: Szummy, Jonathon A.

CERTIFICATE OF TRANSMISSION/MAILING

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June 9, 2004

  
Rhonda L. Mason

REPLY BRIEF UNDER 37 C.F.R. § 1.193(b) (1)

Mail Stop APPEAL BRIEF - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits this reply brief under 37 CFR § 1.193(b) (1) in response to the Examiner's Answer (Paper No. 17).

**Reply re Issue 1: the modification proposed by the rejection lacks a reasonable expectation of success**

The Examiner's Answer errs on page 5 in interpreting the word "bendable" in column 1, lines 52-54 of Nagy as the word "resilient" recited in Claims 1, 4, 7 and 13. According to Webster's Dictionary, for example, at the Internet URL "www.merriam-webster.com", the ordinary meaning of the word "bend", as used by Nagy in the intransitive sense, is "to curve out of a straight line or position". In Nagy, the word "bendable" in column 1, lines 52-55 is used to describe the flat-faced metal strap shown in FIG. 1 that is bent into an L-shape to form the vertical leg (24). Clearly Nagy uses the word "bendable" to describe the permanent deformation of the flat-faced metal strap from a straight line into an L-shape.

On the other hand, the word "resilient" as recited in Claim 1 and used the specification, for example, on page 7, lines 14-22, differentiates between a spring and a rigid bracket. The ordinary meaning of the word "resilient" according to Webster's Dictionary is "capable of withstanding shock without permanent deformation or rupture", which is consistent with the description of the spring in the specification.

Because the word "bendable" in Nagy clearly refers to the permanent deformation of a metal strap into an L-shape, the PTO's interpretation of the word "bendable" in Nagy contradicts the ordinary meaning of the word "resilient" recited in the claims. Because the PTO's interpretation of the word "bendable" in Nagy contradicts the ordinary meaning of the word "resilient" recited in the claims, the PTO's interpretation of the word "bendable" in Nagy and the use of that interpretation to support the rejection of Claims 1-20

are invalid.

The Examiner's Answer further errs on page 5 in alleging that Nagy inherently suggests the claimed force constant selected to produce a displacement of the distal portion of the vertical leg (24) so that the paintbrush (10) does not slide off the magnet (48) when subjected to a mechanical shock. The Examiner's Answer argues on page 6 that Nagy shows in FIG. 1 that the paintbrush (10) is attached to the magnet (48), therefore there must be some force constant selected to produce a displacement of the distal portion of the vertical leg (24) when the paintbrush (10) is subjected to a mechanical shock so that the paintbrush (10) does not slide off the magnet (48).

However, the Examiner's Answer fails to provide any support in Nagy for the gratuitous conclusion that FIG. 1 includes subjecting the paintbrush (10) to a mechanical shock, for example, caused by setting the can (6) down abruptly. Clearly the rejection relies on hindsight gleaned solely from Appellant's disclosure to arrive at the conclusion that Nagy includes subjecting the paintbrush (10) to a mechanical shock in FIG. 1. In fact, the Examiner's Answer admits on page 9 that Nagy does not even recognize the need to mechanically isolate the paintbrush (10) from the can (6). The fact that Nagy does not even recognize the need to mechanically isolate the paintbrush (10) from the can (6) argues strongly against the PTO's conclusion that Nagy includes subjecting the paintbrush (10) to a mechanical shock in FIG. 1.

As explained in the Appeal Brief, the rejection provides neither a basis in fact nor the technical reasoning to support the conclusion that the claimed force constant necessarily flows from the teachings of the applied prior art as required by MPEP § 2112 to support the PTO's allegation

that the claimed force constant is inherent in Nagy.

The Examiner's Answer further errs on page 6 in mischaracterizing Appellant's argument that the vertical orientation of the vertical leg (24) in Nagy would result in transforming most of the force between the paintbrush (10) and the can (6) into compression or tension. Appellant's argument does not require that the member (24) be perfectly vertical as implied by the Examiner's Answer. In column 2, lines 44-46, Nagy describes the member (24) as follows:

"This strap is bent upon itself between its ends as at 22 to provide an upstanding vertically disposable leg 24 and an adapter bracket 26."

According to well-known principles of mechanics, the nearly vertical orientation of the "vertically disposable leg" (24) in FIG. 1 of Nagy is sufficient to substantiate Appellant's technical reasoning that most of the force between the paintbrush (10) and the can (6), for example, when the can (6) is picked up or set down abruptly, would be transformed into compression or tension in the vertical leg (24). The resulting compression or tension in the vertical leg (24) would not result in a significant displacement of the distal portion of the vertical leg (24) to reduce acceleration of the paintbrush (10), even if the vertical leg (24) were resilient as alleged by the rejection.

Because the Examiner's Answer does not contest Appellant's position that the nearly vertical orientation of the vertical leg (24) in Nagy would result in transforming most of the force between the paintbrush (10) and the can (6) into compression or tension so that there would be no significant displacement of the distal portion of the vertical leg (24) to reduce acceleration of the paintbrush (10), the rejection fails to establish a reasonable expectation of

success in arriving at the claimed invention as required by MPEP § 2142 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Further, as explained in the Appeal Brief, Nagy teaches away from the claimed resilient member by expressing a preference, for example, in the abstract, for implementing the vertical leg (24) as a flat-faced metal strap to support the paintbrush, which typically results in the paintbrush (10) sliding off the magnet into the paint when the paintbrush (10) is subjected to a mechanical shock as explained by Appellant in the specification. Because Nagy teaches away from the claimed resilient member, the rejection fails to establish a reasonable expectation of success in arriving at the claimed invention as required by MPEP § 2142 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

The Examiner's Answer further errs on page 6 and on page 7 in denying that the rejection requires a modification of Nagy to arrive at the claimed invention and in alleging that the claimed selected force constant is inherent in Nagy. If no modification of Nagy is required to arrive at the claimed invention, then the rejection should properly be based on anticipation, not obviousness. The admission by the rejection that the specific value of the claimed force constant is not taught in Nagy does not preclude anticipation, if in fact the specific value of the claimed force constant is inherent in Nagy as alleged in the rejection. Because the rejection is not based on anticipation, however, the rejection must propose a modification of Nagy to arrive at the claimed invention and must show a motivation in Nagy for making the proposed modification to substantiate a rejection under 35 CFR § 103 according to MPEP § 2142 (2100-124). Because the PTO refuses to propose such a modification and refuses to provide

a motivation for making the proposed modification, the rejection fails to establish a reasonable expectation of success as required by MPEP § 2142. Because the rejection fails to meet the requirements of MPEP § 2142, the rejection lacks the support necessary to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

**Reply re Issue 2: the claimed force constant is not inherent in Nagy**

The Examiner's Answer further errs in alleging on page 8 that the vertical leg (24) in Nagy is not described and shown in FIG.1 as a rigid bracket. No displacement of the distal portion of the vertical leg (24) is shown or described by Nagy that would prevent the paintbrush (10) from sliding off the magnet (48) when the paintbrush (10) is subjected to a mechanical shock. Because no displacement of the distal portion of the vertical leg (24) is shown or described in Nagy that would prevent the paintbrush (10) from slipping off the magnet (48) when the paintbrush (10) is subjected to a mechanical shock, and because Nagy does not recognize the need to mechanically isolate the paintbrush (10) from the can (6), and because the characterization of the vertical leg (24) by Nagy as "bendable" contradicts the ordinary meaning of "resilient", it is reasonable to conclude that the vertical leg (24) in Nagy is a rigid bracket.

Further, because the vertical leg (24) disclosed in Nagy is not shown or described as having a displacement of the distal portion sufficient to prevent the paintbrush from slipping off the magnet (48) when the paintbrush (10) is subjected to a mechanical shock, the claimed force constant is not shown to be inherent in Nagy as alleged in the rejection.



The rejection further fails to provide a basis in fact and the technical reasoning to support the PTO's conclusion that the claimed force constant necessarily flows from Nagy. Because the rejection fails to provide a basis in fact and the technical reasoning to support the conclusion that the claimed force constant necessarily flows from Nagy, the rejection fails to meet the requirements of MPEP § 2112 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

On the other hand, Appellant has provided both the basis in fact and the technical reasoning to support the conclusion that the claimed force constant cannot be inherent in Nagy. Specifically, the nearly vertical orientation of the vertical leg (24) as shown in FIG. 1 would result in transforming most of the force between the paintbrush (10) and the can (6) into compression or tension in the vertical leg (24) so that there would be no significant displacement of the distal portion of the vertical leg (24) to reduce acceleration of the paintbrush (10).

Because the rejection does not make clear that Nagy shows in FIG. 1 or in the accompanying description that there is a displacement of the distal portion of the vertical leg (24) when the paintbrush (10) is subjected to a mechanical shock sufficient to prevent the paintbrush (10) from sliding off the magnet (48), the rejection clearly fails to substantiate the PTO's allegation that the claimed force constant is inherent in Nagy as required by MPEP § 2142 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Reply re Issue 3: the claimed invention as a whole is not obvious over Nagy

The rejection further errs on page 9 in dismissing

the selection of the claimed resilient member, which includes the claimed force constant, as a "user preference or a design choice" without considering the claimed invention as a whole. As admitted by the Examiner's Answer on page 9, Nagy does not even recognize the need to mechanically isolate the paintbrush (10) from the can (6). Clearly there is no teaching or suggestion in Nagy that would motivate one of ordinary skill in the art to select a resilient member to provide mechanical isolation absent a recognition of the need for the mechanical isolation. Because the rejection fails to consider the invention as a whole, the rejection fails to meet the requirements of MPEP § 2141.02 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

The rejection further errs on page 2 and on page 3 of Paper No. 10 in alleging that Nagy's vertical leg (24) arrives at the claimed invention because it "inherently acts as a spring whenever a force is applied perpendicularly to it". As may readily be appreciated from FIGS. 1 and 2 in Nagy, the force applied to the vertical leg (24) when the paint can (6) is picked up and set down is substantially parallel to the vertical leg (24), not perpendicular as alleged by the rejection. The position of the Appellant that the force applied to the vertical leg (24) is substantially parallel to the vertical leg (24) when the can (6) is picked up and set down is not contested in the Examiner's Answer. As explained above, the nearly vertical orientation of the vertical leg (24) as shown in FIG. 1 would result in transforming most of the force between the paintbrush (10) and the can (6) into compression or tension in the vertical leg (24) so that there would be no significant displacement of the distal portion of the vertical leg (24) to reduce acceleration of the paintbrush (10), even if the vertical leg (24) were

resilient as alleged by the rejection. Because the rejection fails to consider the invention as a whole, the rejection fails to meet the requirements of MPEP § 2141.02 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Reply re Issue 4: the rejection fails to establish a motivation in the prior art to make the proposed modification

The Examiner's Answer insists on page 10 that no modification of Nagy to arrive at the claimed invention is proposed by the rejection because the claimed force constant is allegedly inherent in Nagy, therefore no motivation for making the proposed modification is required to support the rejection under 35 U.S.C. § 103. However, MPEP § 2142 (2100-124) states to the contrary:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Because the rejection admittedly fails to propose a

modification of Nagy to arrive at the claimed invention, and because the rejection fails to establish a motivation in Nagy for making such a modification, there is insufficient support according to MPEP § 2142 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

**Reply re Argument supporting separate patentability of claims on appeal**

The Examiner's Answer further errs on page 10 in alleging that Nagy teaches or suggest the claimed paintbrush holder of Claim 14 wherein the resilient member, the magnet holder, and at least a portion of the clamp constitute a single molded structure. As Nagy shows in FIG. 1 and explains from column 2, line 60 to column 3, line 5, the magnet (48) is held on the upper portion of the leg (24) by a washer (40) and two rectangular cleats (42) and (44) as shown in FIG. 1. The magnet (48), the vertical leg (24), the washer (40), and the two rectangular cleats (42) and (44) are clearly shown as separate structures that are fastened, not molded, by the tang (38) located at (46) on the vertical leg (24) to hold the separate structures together. Because Nagy shows the magnet (48), the vertical leg (24), the washer (40), and the two rectangular cleats (42) and (44) as an assembly of separate structures held together by the bent tang (38), they do not constitute the claimed single molded structure as alleged in the Examiner's Answer.


Also, Nagy teaches in column 2, lines 64-67 that the tang (38) on the upper portion of the vertical leg (24) is bent, meaning permanently deformed, to hold the plate (42) at the location (46). If the vertical leg (24) were equivalent to the claimed resilient member as alleged by the rejection,

then the tang (38) on the vertical leg (24) would return to its unbent position, releasing the magnet (48), the washer (40), and the two rectangular cleats (42) and (44) from the vertical leg (24). The fact that the tang (38) on the vertical leg (24) is bent, that is, permanently deformed, to hold the plate (42) at location (46) on the vertical leg (24) is further evidence that the vertical leg (24) cannot be resilient according to its ordinary meaning. Because the vertical leg (24) cannot be resilient, Nagy teaches away from the claimed resilient member. Because Nagy teaches away from the claimed resilient member, there is insufficient support according to MPEP § 2144.05(III) (2100-138) to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

For the reasons explained above and in the Appeal Brief, Appellant submits that the rejection of Claims 1-20 under 35 U.S.C. § 103 should be vacated.

The fee for an extension of time to June 9, 2004 is attached to this reply brief.

Respectfully submitted,

  
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